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Serial No. : 10/782,856

Attorney's Docket No.: 28957.0159

REMARKS

Claim 1 remains herein.

The Office Action said that claim 1 remained rejected under §102(b) over the assignee's 2003 catalogue published in November 2002, in view of the sale of the claimed plant in the Dutch auctions of 2002. The Office Action alleges that the catalogue published in November 2002 "describes" the instant invention and did so more than 1 year before the February 23, 2000 U.S. filing date of the instant application. The Office Action also alleges that the fact that the plant was sold in late 2002 in the Netherlands (outside the United States) "provides extrinsic evidence that the November 2002 publication was enabled." The Office Action further argues that the late 2002 sale outside the United States does "place the public in possession of the claimed invention before the critical date," arguing that such "possession in the United States is irrelevant because this is not the portion of the statute . . . on which the rejection is based."

Applicant respectfully requests reconsideration and withdrawal of this rejection because it both misunderstands the facts, and misstates the law.

First, any sale outside the United States does not qualify as de jure prior art under any part of 35 U.S.C. §102. Nor has applicant admitted that any sales outside the United States are prior art to the present application. Therefore the sales outside the United States are not available for any purpose whatsoever as prior art under §102.

As stated at page 4 of the Request for Reconsideration filed June 18, 2007:

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There is no evidence in this record that sales in the Netherlands any time more than one year before the filing date of the present application, in fact resulted in, or could have resulted in, possession in the United States of plant material "to practice asexual reproduction of the plant" as claimed herein in a manner consistent with the statute. See *Elsner*, 381 F. 3d at 1128-29. [emphasis in original]

Additionally, the assertion in the Office Action that the late 2002 sales outside the United States provide evidence that the November 2002 publication "was enabled" is without evidentiary basis, and thus clearly erroneous.

A claimed invention cannot be anticipated by a prior art reference if the allegedly anticipatory disclosures cited as prior art are not enabled. Long ago our predecessor court recognized that a non-enabled disclosure cannot be anticipatory (because it is not truly prior art) if that disclosure fails to 'enable one of skill in the art to reduce the disclosed invention to practice.' *In re Borst*, 345 F.2d 851, 855, 145 USPQ 554, 557 (C.C.P.A. 1962); accord, *In re Donohue*, [766 F.2d 531, 533, 226 USPQ 619, 621 (Fed. Cir. 1985).]

*Amgen Inc. v. Hoechst Marion Roussel, Inc.*, 314 F.3d 1313, 65 USPQ2d 1385 (Fed. Cir. 2003)

As tacitly admitted in the Office Action, applicant's claimed invention cannot be produced without physical possession of the plant material. As previously demonstrated in this record, the PTO has cited no evidence that there was, or could have been, possession of such plant material in the United States more than one year before the February 23, 2004 filing date of the instant application. The November 2002 sale in the Netherlands, outside the United States, occurred only about 3 months prior to the February 23, 2003 one year date before the February 23, 2004 filing date of the instant application. It is well known in this art that such plant material cannot be imported into the United States for use without a six-month quarantine period before public dissemination and use. Thus it would have been completely impossible for anyone

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lawfully to have had possession of the necessary plant material in the United States more than one year before the filing date of the instant application.

Thus, in summary, the PTO has continuously admitted that the publication identifying, depicting, and even describing in words, a plant, cannot be an enabling disclosure absent possession of the plant material. Furthermore, the PTO admits that the facts of this case are that the only known sale of such plant material more than one year before the filing date of the instant application occurred outside the United States, and thus is in no way prior art under any part of 35 U.S.C. §102. And, applicant has demonstrated that there is no evidence in this record that anyone in the United States was in possession of plant material necessary to enable making the claimed invention. Accordingly, this record does not state a sound factual or a sound legal basis for rejection of applicant's claim under §102(b).

Thus, applicant respectfully requests reconsideration and withdrawal of the rejection and allowance of this application.

Respectfully submitted,



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